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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,422	12/05/2003	Joseph W. Cole	112300-3391	9411

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EXAMINER	
MOSSER, ROBERT E	

ART UNIT	PAPER NUMBER
3714	

NOTIFICATION DATE	DELIVERY MODE
05/12/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

Office Action Summary	Application No.	Applicant(s)	
	10/728,422	COLE ET AL.	
	Examiner	Art Unit	
	ROBERT MOSSER	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *5th February 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24 and 26-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24 and 26-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1-4, 9-10, 21-24, 30-33,** and **36-37** are rejected under 35 U.S.C. 102(b) as being anticipated by Marnell (US 5,393,057).

Claims **1-3,** and **21-24**: Marnell teaches a method of playing a game including:

(a) accepting a wager through a wager input device (*Marnell* Col 4:10-30);

(b) presenting a main game of video poker including the generation and display of a random set of cards representing a player hand (*Marnell* Figure 3, Col 4:26-29);

(c) determining the outcome of the main game through the comparison of the player hand to a set of different predetermined winning hands (*Marnell* Col 4:40-56);

(d) awarding a winning amount if the player hand matches a predetermined winning hand (*Marnell* Col 4:40-56);

(e) determining if the winning hand corresponds to a predetermined category of bonus event hands (*Marnell* Col 5:61-6:13) and incrementing the predetermined category of bonus event hands with positive value resultant of a match between the winning player hand and the predetermined category of bonus event hands through an indication of the correlating bonus element on the bonus display (*Marnell* Col 5:61-6:13, 9:20-41);

(f) presenting a bonus event concurrently with the presentation of the main game, the bonus event including: randomly selecting bonus categories and the relative matrix position thereof, in a manner independent of main game outcomes (The population of the bingo Matrix combinations *Marnell* Col 5:51-5:60), and if any value is associated with the selected bonus categories awarding a bonus win responsive to the association (*Marnell* Col 5:61-6:67; 6:18-27);

(g) resetting the values associated with the bonus categories resultant of awarding a bonus prize (*Marnell* Col 10:17-23); and

(h) repeating steps (a) through (g) so as to enable the player accrue category bonus event hands during the play of multiple video poker games (*Marnell* Col 10:24-52)

Marnell teaches the player's automatic participation in the bonus game with the occurrence of qualifying events as cited above. The claimed characterization that a player causes the play of the bonus game responsive to the occurrence of a qualifying event, is understood to encompass the automatic player participation in the bonus event resultant of the players placement of a wager.

With reflection to the claim language as presented, the claim sets forth a main game that increments values associated with bonus categories based on the occurrence of similarly characterized game hands during a main game and separate thereto randomly selects the bonus categories and awards the value associated therewith. While the initial step including the presentation of main game hands and the incrementing of values has been previously address with respect to the prior art of

Marnell and in addition to the rejections presented herein, the newly claimed features directed to the random selection of bonus categories is understood to describe the step of populating the bingo matrix in Marnell. Specifically the prior art of Marnell teaches that the bingo matrix is populated independently of the game results (as cited above). In addition to this Marnell further presents that awards of the Marnell are presented according to the values associated with the bonus categories and predetermined bingo patterns.

The claimed steps do not presently include language to limit the order of operation through explicitly limiting the order of step execution, while implicit limitations directed to the order of step execution (if-then statements) do not limit the execution of steps outside of the defined periods (See MPEP 2111.01.II). Specifically, exemplary claim limitation of, -if the player wins the base game presenting the bonus game to the player- does not preclude prior art that would provide for both the original exemplary statement and in addition thereto the following statement -if the player fails to win the base game presenting the bonus game to the player-

Claim **4:** As presented above, the prior art of Marnell displays the play of the bonus event prior to and including the game portion wherein at least one value is associated with each bonus category.

Claims **9-10,** and **30-31**: Marnell teaches a method of playing a game including:

restricting play to a base game when said wager is below a threshold and allowing play of the bonus game when the wager is above a threshold (*Marnell* Col 5:37-50); and

funding the bonus award from a portion of the player wagers in a progressive prize system (Col 4:63-5:7) wherein the percentage of the progressive prize awarded to the respective players is based on their score (*Marnell* Col 10:14-23).

Claims **32** and **36**: In the invention of Marnell, each time a value is associated with a predetermined bonus category (alternatively described as a bingo space) of Marnell the probability of awarding a bonus win in connection with the play of the bonus event increases because the probability of defining winning patterns in the bingo grid of Marnell increases inherently therewith.

Claims **33** and **37**: The average expected payout of a game is understood to be equal to the average prize for a game multiplied by the probability of acquiring a prize during the game. Following therefrom and the rejection of at least claim **32** presented above as the probability of acquiring a prizes increases each time a value is associated with a bonus categories the average expected payout must inherently also increase.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **11-14, 19-20,** and **34-35** are rejected under 35 U.S.C. 103(a) as being unpatentable over Marnell (US 5,393,057)

Claim **11**: Marnell teaches a method of playing a game as set forth above including the use of wild cards in the base game and combinations based thereon in the bonus game (*Marnell* Col 8:62-64) however is silent regarding the inclusion of a bonus category wherein said bonus category is associated with a value which represents a combination of all remaining bonus categories. The inclusion of a bonus category associated with a plurality of values (and hence at least one value) which represents a combination of all values is understood to specify the last bonus category that would complete a coverall/blackout bingo pattern as it is associated with a category (space of the bingo pattern) and would additionally associated with a plurality of values representing the combination of all values on the game board according to the winning pattern established. The Examiner gives official notice that the utilization of coverall/blackout bingo pattern is exceptionally old and well known in the art of Bingo.

Accordingly it would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated coverall/blackout bingo pattern into the invention of Marnell at the time of invention because such a combination of wild symbols and symbol categories would have represented the use of known gaming features combined in conventional manners to yield the predictable of providing a bonus category that would yield an instant win regardless of the bingo target pattern.

Claims **12-14**: The respective limitations of claims **12-14** are presented and redressed above under the redress of at least claims **1-4.**

Claims **19-20**: The respective limitations of claims **19-20** are presented and redressed above under the redress of at least claims **9-10**.

Claim **34**: The respective limitations of claim **34** are presented and redressed above under the redress of at least claims **32** and **36**.

Claim **35**: The respective limitations of claims **35** are presented and redressed above under the redress of at least claims **33** and **37**.

Claims **5-8, 15-18, 26-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Marnell (US 5,393,057) as applied to at least claims **1-4, 9-10, 21-24,** and **30-31** above, and further in view of Bennett (US 6,419,579).

Marnell teaches a method of playing a game as set forth above, however Marnell is silent regarding the utilization of two dice to determine a multiplier utilized in combination with a bonus winning to determine an additional payout amount or equivalently described as a score. In a related invention, Bennett teaches the utilization of dice feature including the incorporation of two dice in a card game to determine a supplemental payout amount (*Bennett* Figure 2; Col 1:51-2:44). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the utilization of dice to determine a supplemental prize multiplier as taught by Bennett into the invention of Marnell in order to maintain a player interest in a gaming machine as taught by Bennett (*Bennet*t Col 5-15).

Response to Arguments

Applicant's arguments filed February 5th, 2009 have been fully considered but they are not persuasive.

On pages 14 through 15 of the applicant's remarks the applicant challenges the motivation to combine the references of Marnell and Devaull. This issue is considered remedied as the amended claim language no longer calls for the use of Devaull in the pending rejections and in accordance therewith is not presently relied upon in the rejections as presented above.

On pages 15 through 17, the applicant argues that the prior art of Marnell and Devaull do not provide for the newly amended feature of "enabling a player to cause play of the bonus event if a bonus condition occurs". Respectfully Marnell in isolation teaches that player is enabled to cause to play of the bonus event through participation in a base game and including during the occurrence of bonus events (Marnell abstract).

Arguments directed to a previously proposed modification of Marnell in view of Devaull are not representative of the present claim language as amended or the present rejections thereof and are accordingly moot.

On pages 17 through 18 the applicant argues the newly amended feature of randomly selecting at least one of the bonus categories in addition to and independent of any previously displayed play of the main game. As addressed in the rejection presented above the presented claim language broadly encompasses the machine selection of bonus categories associated with the bingo matrix in the procedure of associating each matrix location with a particular bonus category as disclosed in the Marnell reference.

On page 18 through 19 the applicant draws attention to the Examiner's reliance on portions of the Marnell references that are directed to multi-player embodiments. As the multiplayer embodiments are presented in a restrictive fashion from the remaining component of the invention of Marnell and the pending claims do not presently limit the number of players, it is presently unclear why the applicant has felt the need to draw attention to this feature.

On pages 20 through 21 the applicant argues the rejection of claim under Marnell Devaull and Bennett is improper based on the reliance on claims rejected therein on independent claims argued above. These claims 5-8,15-18, and 28-29 address by the applicant are addressed under the rejection of Marnell and Bennett as presented above and maintained for the reasons presented above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT MOSSER whose telephone number is (571)272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/
Supervisory Patent Examiner, Art Unit 3714

/R. M./
Examiner, Art Unit 3714